

REMARKS

Claims 1-6 remain pending in the present application; and Claims 1 and 6 have been amended.

Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

DRAWINGS

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 20, 2002, have been disapproved because they introduce new matter into the drawings. Applicants respectfully transverse this disapproval.

The specification on page 12, paragraph 29 states that it is within the scope of the present invention, as shown in Figure 5, to incorporate valve assembly 64 on either side of piston 32 if desired. On page 10, paragraph 24, it states that valve assembly 64 comprises a variable orifice bleed disc 90 and a supporting disc 92. Thus, it is clear that valve assembly 64 must include at least discs 90 and 92. Original Figure 5 identifies valve assembly valve assembly 64 and, therefore, the two discs shown in Figure 5 can only be discs 90 and 92. To define these discs using another reference numeral expands the definition of valve assembly 64; and the expansion of this definition clearly lacks support in the specification. If the valve assembly in Figure 5 was identified by a reference numeral other than 64, Applicants would agree with the Examiner; however, Figure 5 clearly defines valve assembly 64, which comprises discs 90 and 92.

Reconsideration and approval of the previously-filed drawing correction is respectfully requested.

SPECIFICATION

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The specification has been amended to overcome the objection.

Withdrawal of the objection is respectfully requested.

35 U.S.C. § 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." Applicants have reviewed the specification and has amended it where "full, clear, concise, and exact terms" were not used.

Withdrawal of the objection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

Claim 6 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

Claim 6 has been amended to define the mid/high speed valve as including only two valve discs, the two valve discs being the first and second valve discs. Applicants believe this revised wording allows the mid/high speed valve to include additional components, but none of these components can be an additional valve disc.

Reconsideration of the rejection is respectfully requested.

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Claim 1 has been amended to correct the typographical error. Likewise, Claims 2 and 3, which ultimately depend from Claim 1, have been amended to correct the typographical error.

Reconsideration of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,042,624 to **Furuya et al.** in view of U.S. Patent 5,529,154 to **Tanaka** and U.S. Patent 4,964,493 to **Yamaura et al.** This rejection is respectfully traversed.

As stated by the Examiner, **Furuya et al.** does not provide support for the outer edge of the second valve disc as being chordal. The Examiner then looks to **Tanaka**.

Contrary to the Examiner's position, **Tanaka** in column 5, lines 46-51 teaches that **recess 19a**, not "outer edge 19a," can vary in number, shape, angle and depth. The word "recess" is defined as an indentation or small hollow in the office edition of The American Heritage Dictionary and the figures of **Tanaka** clearly illustrate an indentation or small hollow. A chordal edge falls outside the definition of a recess.

The Examiner then goes to **Yamaura et al.** to find a second valve disc 144, which is adjacent to a first valve disc 138 via element 142. The problem here is that stopper plate 144 is not adjacent to the first valve disc 138; it is spaced from first valve disc 138 by washer 142. The Examiner then states that the second valve disc 144 has an outer edge that supports the first valve disc. Applicants have reviewed the various figures of **Yamaura et al.** and is unable to find anywhere in these figures anything that supports the Examiner's position. All of the figures clearly illustrate that stopper plate

144 is spaced from the first valve disc 138 and that the edge of stopper plate 144 does not support the first valve disc.

The Examiner is relying on hindsight to arrive at the determination of obviousness. The court in *In Re Fritch*, 23 USPQ 2d 1784 (Fed. Cir. 1992), stated that it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This is exactly what the Examiner has done here. The Examiner has pieced together the three references to allegedly render Applicants' invention obvious, which is clearly shown due to the fact that the prior art even lacks some of the limitations of the claimed invention as discussed above.

Thus, Applicants believe Claim 1 patentably distinguishes over the art of record. Likewise, Claims 2-5, which ultimately depend from Claim 1, are also believed to patentably distinguish over the art of record.

Reconsideration of the rejection is respectfully requested.

Claim 6 is rejected under 35 U.S.C. § 103(a) as unpatentable over *Yamaura et al.* in view of *Tanaka*. This rejection is respectfully traversed.

The discussion above regarding *Yamaura et al.* and *Tanaka* apply equally well here. This prior art fails to teach the limitations of the claims without resorting to impermissible hindsight.

Thus, Applicants believe Claim 6 patentably distinguishes over the art of record.

Reconsideration of the rejection is respectfully requested.

DOUBLE PATENTING

Claims 1, 2 and 3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 2 and 3 of copending Application No. 09/552,125 in view of ***Tanaka*** and ***Yamaura et al.*** **Claims 4 and 5** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 8 and 9 of copending Application No. 09/552,125 in view of ***Furuya et al.***, ***Tanaka*** and ***Yamaura et al.*** **Claim 6** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 14 of copending Application No. 09/552,125 in view of ***Yamaura et al.*** in view of ***Tanaka***. Applicants respectfully transverse these rejections.

The above discussion regarding ***Tanaka***, ***Yamaura et al.*** and ***Furuya et al.*** apply here also.

Thus, Applicants believe that the double patenting rejection should be withdrawn.

Reconsideration of the rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the

Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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